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Paper No. 9

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In re Application of : OFFICE OF PETITIONS
Chi-Ying Tsui et al :
Application No. 09/804,069 : ON PETITION
Filed: March 12, 2001 :
Attorney Docket No. 4522/9 :

This is a decision on the petition under 37 CFR 1.137(a), filed January 23, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely submit a reply to the Notice to File Missing Parts of Nonprovisional Application (Notice) on or before June 20, 2001.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;¹ (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). This petition lacks item (3).

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

In this regard, as to item (3), petitioner asserts that the delay was caused by nonreceipt of the Notice of Incomplete Reply (Nonprovisional) dated June 18, 2001.

The USPTO acknowledges the timely receipt of a partial reply on May 29, 2001. However, the Notice mailed April 20, 2001, additionally required the submission of substitute drawings in compliance with 37 CFR 1.84 because the "drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must have a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch)." Therefore, timely compliance with this requirement must have been made in order to avoid the abandonment of the application. The Notice of Incomplete Reply (Nonprovisional) mailed June 18, 2001 again required the submission of substitute drawings and indicated that "[t]he period of reply remains as set forth in the Notice."

On reviewing the transmittal letter (Exhibit D) submitted with the partial reply of May 29, 2001, there is no indication that petitioner submitted substitute drawings as required by the April 20, 2001 Notice within the maximum extendable period for reply.

MPEP 608.02(b) states that "[i]f a drawing is not timely received in reply to a notice from the Office or a letter from the examiner who requires a drawing, the application becomes abandoned for failure to reply." That is, applicants were given Notice that substitute drawings had to be supplied to avoid the abandonment of this application.

Furthermore, petitioner concededly received the Notice of April 20, 2001 but failed to provide the necessary complete reply. The failure to supply a complete reply was the fault of petitioner, not the USPTO. As noted in Brenner v. Ebbert, 398 F.2d. 762, 157 USPQ 609, 611 (D.C. Cir. 1968), cert. den. 159 USPQ 799.

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner has received the reasonable notice required so as ensure a timely and full response to the Notice. In this regard, the Notice of April 20, 2001 required, *inter alia*, the submission of substitute drawings and set a period within which to supply the reply required by the Notice. Since substitute drawings were not received at the time of filing the partial reply on May 20, 2001, the Office mailed a courtesy Notice of Incomplete Reply, but did not reset the period for supplying the drawings required by the Notice of April 20, 2001. Unfortunately, while the notice was mailed to the previous address, petitioner is advised that failure to receive this latter notice did not result in the abandonment of the application, but, rather, was due to applicants' failure to supply the complete reply as required by the Notice mailed April 20, 2001. It should be noted that, although attempts are made to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so. See In re Colombo Inc., 33 USPQ2d, 530, 1532 (Comm'r Pat. 1994). That petitioner failed to timely and adequately respond was unfortunate, but such failure did not operate to save this application from abandonment, nor was the failure to properly reply unavoidable delay. See Brenner, *supra*.

The Notice dated November 21, 2002 projected that the application would be "first examined in 12 to 15 months from today." Unfortunately, while this notice was improper, this notice was not a contributing factor in the abandonment of the application since it was mailed after the expiration of the extendable period for reply. Therefore, petitioner has failed to provide adequate evidence that the delay was unavoidable.

If petitioner cannot provide evidence of the nature required to establish unavoidable delay or simply does not wish to, petitioner may wish to consider filing a petition filing a petition under the unintentional provisions of 37 CFR 1.137(b). Public Law 97-247, which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." See 37 CFR 1.137(b) in effect as of December 1, 1997. Note *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. 53131 (October 10, 1997), 1203 Off. Gaz. Patent Office 63 (October 21, 1997). An "unintentional" petition must be accompanied by the \$665.00 petition fee.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement of unintentional delay is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Receipt is acknowledged of the substitute drawings. Unfortunately, the Office accidentally placed a stamp on the first page of the drawings sheet and is unusable. Therefore, a substitute drawing of sheet one is required.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.


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